

REMARKS

Applicants have reviewed and considered the Office Action dated October 4, 2004 and the references cited therewith. Claims 11, 13, 18 and 19 are amended, claims 1-10 are canceled without prejudice or disclaimer, and claims 26-32 are added. As a result, claims 11-32 are now pending in this application. Applicants hereby request further examination and reconsideration of the application, in view of the following remarks.

Objection to the Drawings

In amended FIG. 1, element numeral 106 has been amended to correctly lead to the right atrium of the heart.

§112 Rejection of the Claims

Claims 11-18, 13-16, and 19-25 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicant has amended claims 11, 13, and 19 to clarify the subject therein. The amendment makes express of what was implicit in the claim as originally worded.

Applicants respectfully request withdrawal of this 35 USC § 112, second paragraph, basis of rejection of claims 11-18, 13-16, and 19-25.

§102 Rejection of the Claims

Claims 11-12 and 16-18 were rejected under 35 USC § 102(e) as being anticipated by Salo (U.S. Publication No. 2003/0125774). Applicants respectfully submit that the Office Action has not made out a *prima facie* case of anticipation on at least two grounds.

First, anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon*, 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990)(en banc), cert. denied, 500 U.S. 904 (1991). “Anticipation requires the presence in a single prior reference disclosure of *each and every element* of the claimed invention, *arranged as in the claim*.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d

1452, 221 USPQ 481, 485 (Fed. Cir. 1984)(citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983))(emphasis added).

Second, the fact that a certain result or characteristic *may* occur or be present in the prior art is *not sufficient to establish the inherency* of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(emphasis added); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘*must make clear that the missing descriptive matter is necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may result* from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(emphasis added). “In relying upon the theory of inherency, the *examiner must provide a basis* in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)(emphasis added).

Applicant cannot find in the cited reference placing at least one thermal sensor within a coronary sinus and measuring a myocardium temperature from within the coronary sinus as recited in claim 11. Claims 12, 16-18 contain additional limitations to claim 11 and are likewise not anticipated by the reference. Accordingly, Applicants respectfully request withdrawal of this 35 U.S.C. § 102 basis of rejection of claims 11-12 and 16-18.

Furthermore, Applicant traverses the rejection because no reasoning was provided to support the allegedly inherent characteristic.

A *prima facie* case has not been established because, as recited in MPEP § 2112, “[i]n relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art,” citing *Ex parte Levy* at 1464 (emphasis in original).

To serve as an anticipation when a reference is silent about the asserted inherent characteristic, the gap in the reference may be filled with recourse to extrinsic evidence. But, such evidence must make clear that “the missing descriptive mater is necessarily present in the

thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *Continental Can Co. v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Applicants respectfully submit that the Examiner has not produced extrinsic evidence to show that the claim language recited in claims 16 and 17 is necessarily present in Salo. Accordingly, Applicants respectfully request withdrawal of this 35 USC § 102 basis of rejection of claims 16-17.

Common Ownership

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered to be owned by, or subject to an obligation of assignment to, the same person at the time the invention was made, if the applicants or the applicants’ attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. (Official Gazette Notice, 1241 OG 96 (Dec. 26, 2000)). “The statement concerning common ownership should be clear and conspicuous (e.g., on a separate piece of paper *or in a separately labeled section*).” *Id.* (emphasis added).

Applicants assert that Salo (U.S. Patent Publication 2003/0125774) and the above-identified patent application were owned by, or subject to an obligation of assignment to, the same person at the time that any invention in such patent application was made.

§103 Rejection of the Claims

Claims 13-14 and 19-20 were rejected under 35 USC § 103(a) as being unpatentable over Salo (U.S. Publication No. 2003/0125774). Applicants respectfully traverse.

A reference asserted as prior art under 102(e), (f), or (g), that was commonly owned with an application at the time the invention therein was made, cannot preclude patentability under 35 USC § 103 of the claims of the application when the application was filed on or after November 29, 1999. Official Gazette Notice, 1233 OG 55 (April 11, 2000). Currently 35 USC § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, *shall not preclude patentability* under this section where the subject matter and the claimed invention were, at the time the invention was made, *owned by the same person or subject to an obligation of assignment to the same person*.

(emphasis added).

The primary reference asserted by the Examiner cannot preclude patentability under 35 USC § 103:

Applicants respectfully submit that Salo (U.S. Patent Publication 2003/0125774) is not prior art with respect to claims 13-14 and 19-20 of the present application. A reference asserted as prior art under 35 USC § 102(e), (f), or (g) that was commonly owned with an application at the time the invention therein was made, cannot preclude patentability under 35 USC § 103 of the claims of the application when the application was filed on or after November 29, 1999. 35 USC § 103(c); 1233 OG 33 (April 11, 2000). The present application was filed on March 1, 2002, as shown by the attached copy of the Filing Receipt, which is after November 29, 1999. Salo (U.S. Patent Publication 2003/0125774) and the present application were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person (Cardiac Pacemakers, Inc., St. Paul, MN (US)).

Thus, Salo (U.S. Patent Publication 2003/0125774) is commonly owned by, or subject to an obligation of assignment to, the same person as the present application and is therefore not prior art with respect to claims 13-14 and 19-20 of the present application as indicated by the Office Action. Accordingly, Applicants respectfully request withdrawal of this 35 U.S.C. § 103 basis of rejection of claims 13-14 and 19-20.

Reservation of Right to Swear Behind References

Applicant reserves the right to swear behind any references which are cited in a rejection under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), and 103/102(e). Statements distinguishing the claimed subject matter over the cited references are not to be interpreted as admissions that the references are prior art.

Allowable Subject Matter

Claims 15 and 20-25 were indicated to be allowable if rewritten to overcome the rejections under 35 USC § 112, second paragraph, set forth in the Office Action and to include all of the limitations of the base claim and any intervening claims.

The Applicants acknowledge the allowability of claims 15 and 20-25 if rewritten to incorporate the elements of their parent claims and overcome the rejections under 35 USC § 112, second paragraph, and reserve the right to rewrite such claims 15 and 20-25.

Conclusion

In view of the above, Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 359-3276 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

QINGSHENG ZHU ET AL.

By their Representatives,

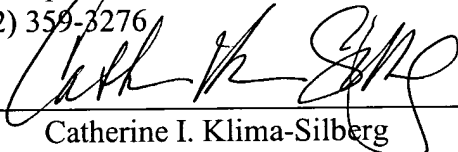
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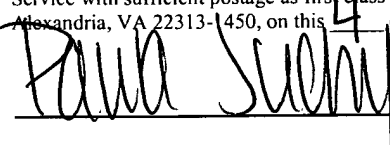
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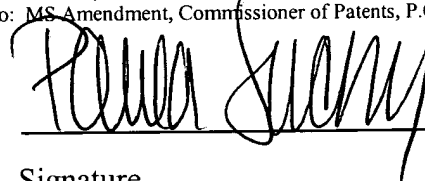
Date Jan. 4, 2005

By 
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Attachments

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 4 day of January, 2005.


Name


Signature

IN THE DRAWINGS

The drawings currently stand objected to because “106 leads to the left atrium [of the heart], while the specification claims it leads to the right atrium [of the heart].” (Office Action dated October 4, 2004, Drawings, pp. 6, lns. 1-2). The attached sheets of drawings includes changes to FIG. 1. The sheet labeled “Replacement Sheet,” which includes FIG. 1, replaces the original sheet including FIG. 1.